

8-28-01

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PTO/SB/05 (03-01)

Approved for use through 10/31/2002 OMB 0651-0032

U.S. Patent and Trademark Office, U.S. DEPARTMENT OF COMMERCE

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# UTILITY PATENT APPLICATION TRANSMITTAL

(Only for new nonprovisional applications under 37 CFR 1.53(b))

Attorney Docket No.

52846-5001-02

First Inventor

LOEB

Title

Method and Apparatus for Providing  
Open-Ended Subscriptions to Commodity  
Items...

Express Mail Label No.

EL 719 359 686 US

## APPLICATION ELEMENTS

See MPEP chapter 600 concerning utility patent application contents.

ADDRESS TO:

Assistant Commissioner for Patents  
Box Patent Application  
Washington, DC 202311. ☐ Fee Transmittal Form (e.g., PTO/SB/17)  
(Submit an original and a duplicate for fee processing)2. ☐ Applicant claims small entity status.  
See 37 CFR 1.27.3. ☒ Specification [Total Pages 52] *plus title page*  
(preferred arrangement set forth below)

- Descriptive title of the invention
- Cross Reference to Related Applications
- Statement Regarding Fed sponsored R & D
- Reference to sequence listing, a table, or a computer program listing appendix
- Background of the Invention
- Brief Summary of the Invention
- Brief Description of the Drawings (if filed)
- Detailed Description
- Claim(s)
- Abstract of the Disclosure

4. ☒ Drawing(s) (35 U.S.C. 113) [Total Sheets 13]

5. Oath or Declaration [Total Pages 6]

- a. ☐ Newly executed (original or copy)
- b. ☒ Copy from a prior application (37 CFR 1.63 (d))  
(for continuation/divisional with Box 18 completed)

i. ☐ **DELETION OF INVENTOR(S)**  
Signed statement attached deleting inventor(s)  
named in the prior application, see 37 CFR  
1.63(d)(2) and 1.33(b)

6. ☒ Application Data Sheet. See 37 CFR 1.767. ☐ CD-ROM or CD-R in duplicate, large table or  
Computer Program (Appendix)8. Nucleotide and/or Amino Acid Sequence Submission  
(if applicable, all necessary)

- a. ☐ Computer Readable Form (CRF)
- b. Specification Sequence Listing on:
- i. ☐ CD-ROM or CD-R (2 copies); or
  - ii. ☐ paper
- c. ☐ Statements verifying identity of above copies

## ACCOMPANYING APPLICATION PARTS

9. ☐ Assignment Papers (cover sheet & document(s))10. ☐ 37 CFR 3.73(b) Statement ☒ Power of  
(when there is an assignee) Attorney11. ☐ English Translation Document (if applicable)12. ☐ Information Disclosure ☐ Copies of IDS  
Statement (IDS)/PTO-1449 Citations13. ☐ Preliminary Amendment14. ☒ Return Receipt Postcard (MPEP 503)  
(Should be specifically itemized)15. ☐ Certified Copy of Priority Document(s)  
(if foreign priority is claimed)16. ☐ Nonpublication Request under 35 U.S.C. 122  
(b)(2)(B)(i). Applicant must attach form PTO/SB/35  
or its equivalent.17. ☐ Other: .....18. If a CONTINUING APPLICATION, check appropriate box, and supply the requisite information below and in a preliminary amendment,  
or in an Application Data Sheet under 37 CFR 1.76:☒ Continuation ☐ Divisional ☐ Continuation-in-part (CIP)

of prior application No.: 09 / 370,290

Prior application information:

Examiner

Kalinowski

Group Art Unit:

2166

For CONTINUATION OR DIVISIONAL APPS only: The entire disclosure of the prior application, from which an oath or declaration is supplied under  
Box 5b, is considered a part of the disclosure of the accompanying continuation or divisional application and is hereby incorporated by reference.  
The incorporation can only be relied upon when a portion has been inadvertently omitted from the submitted application parts.

## 19. CORRESPONDENCE ADDRESS

☐ Customer Number or Bar Code Label

(Insert Customer No. or Attach bar code label here)

or ☒ Correspondence address below

Name

DANIEL H. GOLUB

Address

1701 MARKET ST

City

PHILADELPHIA

State

PA

Zip Code

19103

Country

USA

Telephone

2159635055

Fax

2159635299

Name (Print/Type)

ALYSON B. WEISBERG

Registration No. (Attorney/Agent)

45 206

Signature

ALYSON B. WEISBERG

Date

8/27/01

Burden Hour Statement: This form is estimated to take 0.2 hours to complete. Time will vary depending upon the needs of the individual case. Any comments on  
the amount of time you are required to complete this form should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, Washington, DC  
20231. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS SEND TO Assistant Commissioner for Patents, Box Patent Application,  
Washington, DC 20231

1701 Market Street  
Philadelphia, PA 19103-2921  
215-963-5000  
Fax: 215-963-5299

**Morgan, Lewis  
& Bockius LLP**  
C O U N S E L O R S   A T   L A W

Alison B. Weisberg  
215.963.5091  
[aweisberg@morganlewis.com](mailto:aweisberg@morganlewis.com)

August 27, 2001

Assistant Commissioner for Patents  
Washington, D.C. 20231

Box PATENT APPLICATION

Re: U.S. Patent Application for  
"METHOD AND APPARATUS FOR PROVIDING  
OPEN-ENDED SUBSCRIPTIONS TO COMMODITY  
ITEMS NORMALLY AVAILABLE THROUGH TERM-  
BASED SUBSCRIPTIONS"  
Our Ref. No. 52846-5001-02

Dear Sir:

Enclosed for filing in connection with the above-referenced invention are the following:

1. Utility Patent Application Transmittal (1 page);
2. Application Data Sheet (6 pages);
3. New Application Transmittal (12 pages);
4. Added Pages for Application Transmittal (5 pages);
5. Copy of Petition for Two Month Extension of Time and Fee Transmittal And Notification of Filing of Continuation Application (2 pages);
6. Application including 1 title page, 24 pages of specification, 27 pages of claims, 1 page of abstract and 13 pages of drawings;
7. Combined Declaration and Power of Attorney (3 pages);
8. Power of Attorney by Assignee of Entire Interest (Revocation of Prior Powers) (2 pages);

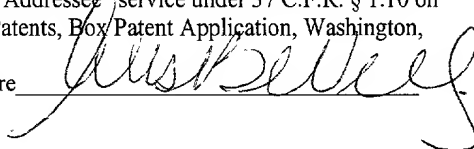
**EXPRESS MAIL CERTIFICATE (37 C.F.R. § 1.10)**

Express Mail Label No. EL719358686US

Date of Deposit August 27, 2001

I hereby certify that this paper, and the papers and/or fees referred to herein as transmitted, submitted or enclosed, are being deposited with the U.S. Postal Service "Express Mail Post Office to Addressee" service under 37 C.F.R. § 1.10 on the date indicated above and is addressed to the Assistant Commissioner for Patents, Box Patent Application, Washington, D.C. 20231.

Name Alison B. Weisberg

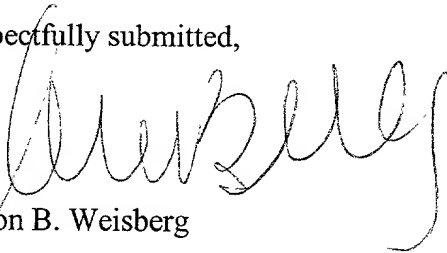
Signature 

Philadelphia   Washington   New York   Los Angeles   Miami   Harrisburg   Pittsburgh   Princeton  
London   Brussels   Frankfurt   Tokyo

9. Associate Power of Attorney (1 page); and
10. Self-addressed, return stamped postcard.

Kindly acknowledge receipt of these documents by returning the enclosed self-addressed, stamped postcard to the undersigned.

Respectfully submitted,



Alison B. Weisberg

Registration No. 45, 206  
MORGAN, LEWIS & BOCKIUS LLP  
1701 Market Street  
Philadelphia, Pennsylvania 19103  
215.963.5091

TO: "2001-08-27" 215.963.5091

## Preliminary Classification:

Proposed Class

Subclass

NOTE "All applicants are requested to include a preliminary classification on newly filed patent applications. The preliminary classification, preferably class and subclass designations, should be identified in the upper right-hand corner of the letter of transmittal accompanying the application papers, for example 'Proposed Class 2, subclass 129' " M P E P § 601, 7th ed



## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

## Box Patent Application

Assistant Commissioner for Patents

Washington, D.C. 20231

## NEW APPLICATION TRANSMITTAL

Transmitted herewith for filing is the patent application of

Inventor(s): JAY S. Walker and Michael R. LOEB

WARNING: 37 C.F.R. § 1.41(a)(1) points out:

"(a) A patent is applied for in the name or names of the actual inventor or inventors

"(1) The inventorship of a nonprovisional application is that inventorship set forth in the oath or declaration as prescribed by § 1.63, except as provided for in § 1.53(d)(4) and § 1.63(d). If an oath or declaration as prescribed by § 1.63 is not filed during the pendency of a nonprovisional application, the inventorship is that inventorship set forth in the application papers filed pursuant to § 1.53(b), unless a petition under this paragraph accompanied by the fee set forth in § 1.17(i) is filed supplying or changing the name or names of the inventor or inventors."

For (title): Method and Apparatus for Providing Open-Ended Subscriptions to Commodity Items Normally Available Only Through Term-Based Subscriptions

## CERTIFICATION UNDER 37 C.F.R. §§ 1.8(a) and 1.10\*

(When using Express Mail, the Express Mail label number is mandatory, Express Mail certification is optional)

I hereby certify that, on the date shown below, this correspondence is being:

## MAILING

☐ deposited with the United States Postal Service in an envelope addressed to the Assistant Commissioner for Patents, Washington, D C 20231

37 C.F.R. § 1.8(a)

37 C.F.R. § 1.10 \*

☐ with sufficient postage as first class mail

☒ as "Express Mail Post Office to Addressee"

Mailing Label No EL 719358686 US (mandatory)

## TRANSMISSION

☐ facsimile transmitted to the Patent and Trademark Office, (703) \_\_\_\_\_

Date: 8/27/01

Signature

Alison B. Weisberg  
(type or print name of person certifying)

\* Only the date of filing (§ 1.6) will be the date used in a patent term adjustment calculation, although the date on any certificate of mailing or transmission under § 1.8 continues to be taken into account in determining timeliness. See § 1.703(f). Consider "Express Mail Post Office to Addressee" (§ 1.10) or facsimile transmission (§ 1.6(d)) for the reply to be accorded the earliest possible filing date for patent term adjustment calculations.

(New Application Transmittal [4-1]—page 1 of 12)

FOI 2001-2904650

1. Type of Application

This new application is for a(n)

(check one applicable item below)

- ☐ Original (nonprovisional)  
☐ Design  
☐ Plant

**WARNING:** Do not use this transmittal for a completion in the U S of an International Application under 35 U S C § 371(c)(4), unless the International Application is being filed as a divisional, continuation or continuation-in-part application

**WARNING:** Do not use this transmittal for the filing of a provisional application

**NOTE** If one of the following 3 items apply, then complete and attach ADDED PAGES FOR NEW APPLICATION TRANSMITTAL WHERE BENEFIT OF A PRIOR U S APPLICATION CLAIMED and a NOTIFICATION IN PARENT APPLICATION OF THE FILING OF THIS CONTINUATION APPLICATION

- ☐ Divisional.  
☒ Continuation  
☐ Continuation-in-part (C-I-P)

2. Benefit of Prior U.S. Application(s) (35 U.S.C. §§ 119(e), 120, or 121)

**NOTE** A nonprovisional application may claim an invention disclosed in one or more prior filed copending nonprovisional applications or copending international applications designating the United States of America. In order for a nonprovisional application to claim the benefit of a prior filed copending nonprovisional application or copending international application designating the United States of America, each prior application must name as an inventor at least one inventor named in the later filed nonprovisional application and disclose the named inventor's invention claimed in at least one claim of the later filed nonprovisional application in the manner provided by the first paragraph of 35 U.S.C. § 112. Each prior application must also be:

(i) An international application entitled to a filing date in accordance with PCT Article 11 and designating the United States of America, or

(ii) Complete as set forth in § 1.51(b), or

(iii) Entitled to a filing date as set forth in § 1.53(b) or § 1.53(d) and include the basic filing fee set forth in § 1.16, or

(iv) Entitled to a filing date as set forth in § 1.53(b) and have paid therein the processing and retention fee set forth in § 1.21(f) within the time period set forth in § 1.53(f)

37 C.F.R. § 1.78(a)(1)

**NOTE** If the new application being transmitted is a divisional, continuation or a continuation-in-part of a parent case, or where the parent case is an International Application which designated the U.S., or benefit of a prior provisional application is claimed, then check the following item and complete and attach ADDED PAGES FOR NEW APPLICATION TRANSMITTAL WHERE BENEFIT OF PRIOR U.S. APPLICATION(S) CLAIMED

**WARNING:** If an application claims the benefit of the filing date of an earlier filed application under 35 U.S.C. §§ 120, 121 or 365(c), the 20-year term of that application will be based upon the filing date of the earliest U.S. application that the application makes reference to under 35 U.S.C. §§ 120, 121 or 365(c). (35 U.S.C. § 154(a)(2) does not take into account, for the determination of the patent term, any application on which priority is claimed under 35 U.S.C. §§ 119, 365(a) or 365(b).) For a c-i-p application, applicant should review whether any claim in the patent that will issue is supported by an earlier application and, if not, the applicant should consider canceling the reference to the earlier filed application. The term of a patent is not based on a claim-by-claim approach. See Notice of April 14, 1995, 60 Fed. Reg. 20,195, at 20,205.

(New Application Transmittal [4-1]—page 2 of 12)

**WARNING:** When the last day of pendency of a provisional application falls on a Saturday, Sunday, or Federal holiday within the District of Columbia, any nonprovisional application claiming benefit of the provisional application **must** be filed prior to the Saturday, Sunday, or Federal holiday within the District of Columbia. See 37 C.F.R. § 1.78(a)(3).

- ☒ The new application being transmitted claims the benefit of prior U.S. application(s). Enclosed are ADDED PAGES FOR NEW APPLICATION TRANSMITTAL WHERE BENEFIT OF PRIOR U.S. APPLICATION(S) CLAIMED.

### 3. Papers Enclosed

- A. Required for filing date under 37 C.F.R. § 1.53(b) (Regular) or 37 C.F.R. § 1.153 (Design) Application

24 Pages of specification

27 Pages of claims

13 Sheets of drawing

**WARNING:** **DO NOT** submit original drawings. A high quality copy of the drawings should be supplied when filing a patent application. The drawings that are submitted to the Office must be on strong, white, smooth, and non-shiny paper and meet the standards according to § 1.84. If corrections to the drawings are necessary, they should be made to the original drawing and a high-quality copy of the corrected original drawing then submitted to the Office. Only one copy is required or desired. For comments on proposed then-new 37 C.F.R. § 1.84, see Notice of March 9, 1988 (1990 O.G. 57-62).

**NOTE:** "Identifying indicia, if provided, should include the application number or the title of the invention, inventor's name, docket number (if any), and the name and telephone number of a person to call if the Office is unable to match the drawings to the proper application. This information should be placed on the back of each sheet of drawing a minimum distance of 1.5 cm. (5/8 inch) down from the top of the page . . ." 37 C.F.R. § 1.84(c)).

(complete the following, if applicable)

- ☐ The enclosed drawing(s) are photograph(s). Three (3) sets of photographs and a "PETITION TO ACCEPT PHOTOGRAPH(S) AS DRAWING(S)" are attached. 37 C.F.R. § 1.84(b).
- ☐ The enclosed drawing(s) are in color. Three (3) sets of color drawings and a "PETITION TO ACCEPT COLOR DRAWING(S)" are attached. 37 C.F.R. §§ 1.84(a)(2) and 1.84(b).
- ☐ formal
- ☐ informal

- B. Other Papers Enclosed

6 Pages of declaration and power of attorney

1 Pages of abstract

     Other

### 4. Additional papers enclosed

- ☒ Amendment to claims
- ☒ Cancel in this applications claims 1-65 before calculating the filing fee. (At least one original independent claim must be retained for filing purposes.)
- ☐ Add the claims shown on the attached amendment. (Claims added have been numbered consecutively following the highest numbered original claims.)

- ☐ Preliminary Amendment
- ☐ Information Disclosure Statement (37 C.F.R. § 1.98)
- ☐ Form PTO-1449 (PTO/SB/08A and 08B)
- ☐ Citations
- ☐ Declaration of Biological Deposit
- ☐ Submission of "Sequence Listing," computer readable copy and/or amendment pertaining thereto for biotechnology invention containing nucleotide and/or amino acid sequence.
- ☐ Authorization of Attorney(s) to Accept and Follow Instructions from Representative
- ☐ Special Comments
- ☐ Other

**5. Declaration or oath (including power of attorney)**

*NOTE: A newly executed declaration is not required in a continuation or divisional application provided that the prior nonprovisional application contained a declaration as required, the application being filed is by all or fewer than all the inventors named in the prior application, there is no new matter in the application being filed, and a copy of the executed declaration filed in the prior application (showing the signature or an indication thereon that it was signed) is submitted. The copy must be accompanied by a statement requesting deletion of the names of person(s) who are not inventors of the application being filed. If the declaration in the prior application was filed under § 1.47, then a copy of that declaration must be filed accompanied by a copy of the decision granting § 1.47 status or, if a nonsigning person under § 1.47 has subsequently joined in a prior application, then a copy of the subsequently executed declaration must be filed. See 37 C.F.R. §§ 1.63(d)(1)–(3).*

*NOTE: A declaration filed to complete an application must be executed, identify the specification to which it is directed, identify each inventor by full name including family name and at least one given name, without abbreviation together with any other given name or initial, and the residence, post office address and country or citizenship of each inventor, and state whether the inventor is a sole or joint inventor. 37 C.F.R. § 1.63(a)(1)–(4).*

*NOTE: "The inventorship of a nonprovisional application is that inventorship set forth in the oath or declaration as prescribed by § 1.62, except as provided for in § 1.53(d)(4) and § 1.63(d). If an oath or declaration as prescribed by § 1.63 is not filed during the pendency of a nonprovisional application, the inventorship is that inventorship set forth in the application papers filed pursuant to § 1.53(b), unless a petition under this paragraph accompanied by the fee set forth in § 1.17(f) is filed supplying or changing the name or names of the inventor or inventors." 37 C.F.R. § 1.41(a)(1).*

☒ Enclosed

Executed by

(check all applicable boxes)

- ☒ inventor(s).
- ☐ legal representative of inventor(s). 37 C.F.R. §§ 1.42 or 1.43.
- ☐ joint inventor or person showing a proprietary interest on behalf of inventor who refused to sign or cannot be reached.
- ☐ This is the petition required by 37 C.F.R. § 1.47 and the statement required by 37 C.F.R. § 1.47 is also attached. See item 13 below for fee.

☐ Not Enclosed.

*NOTE: Where the filing is a completion in the U.S. of an International Application or where the completion of the U.S. application contains subject matter in addition to the International Application, the application may be treated as a continuation or continuation-in-part, as the case may be, utilizing ADDED PAGE FOR NEW APPLICATION TRANSMITTAL WHERE BENEFIT OF PRIOR U.S. APPLICATION CLAIMED.*

- ☐ Application is made by a person authorized under 37 C.F.R. § 1.41(c) on behalf of *all* the above named inventor(s).

*(The declaration or oath, along with the surcharge required by 37 C.F.R. § 1.16(e) can be filed subsequently).*

- ☐ Showing that the filing is authorized.  
*(not required unless called into question. 37 C.F.R. § 1.41(d))*

## 6. Inventorship Statement

**WARNING:** *If the named inventors are each not the inventors of all the claims an explanation, including the ownership of the various claims at the time the last claimed invention was made, should be submitted.*

The inventorship for all the claims in this application are:

- ☐ The same.

or

- ☐ Not the same. An explanation, including the ownership of the various claims at the time the last claimed invention was made,  
☐ is submitted.  
☐ will be submitted.

## 7. Language

**NOTE:** *An application including a signed oath or declaration may be filed in a language other than English. An English translation of the non-English language application and the processing fee of \$130.00 required by 37 C.F.R. § 1.17(k) is required to be filed with the application, or within such time as may be set by the Office. 37 C.F.R. § 1.52(d).*

- ☒ English  
☐ Non-English  
☐ The attached translation includes a statement that the translation is accurate. 37 C.F.R. § 1.52(d).

## 8. Assignment

- ☐ An assignment of the invention to \_\_\_\_\_  
\_\_\_\_\_  
☐ is attached. A separate ☐ "COVER SHEET FOR ASSIGNMENT (DOCUMENT) ACCOMPANYING NEW PATENT APPLICATION" or ☐ FORM PTO 1595 is also attached.  
☐ will follow.

**NOTE:** *"If an assignment is submitted with a new application, send two separate letters—one for the application and one for the assignment." Notice of May 4, 1990 (1114 O.G. 77-78).*

**WARNING:** *A newly executed "CERTIFICATE UNDER 37 C.F.R. § 3.73(b)" must be filed when a continuation-in-part application is filed by an assignee. Notice of April 30, 1993, 1150 O.G. 62-64.*

- ☒ This is a ☒ continuation ☐ divisional application and the assignment document for the parent application 09/ 370,290 was filed on 4/19/00.

Reel 010765

Frame 0214



# 9. Certified Copy

Certified copy(ies) of application(s)

Country	Appln. No.	Filed
Country	Appln. No.	Filed
Country	Appln. No.	Filed

from which priority is claimed

☐ is (are) attached.

☐ will follow.

NOTE: The foreign application forming the basis for the claim for priority must be referred to in the oath or declaration. 37 C.F.R. § 1.55(a) and 1.63.

NOTE: This item is for any foreign priority for which the application being filed directly relates. If any parent U.S. application or International Application from which this application claims benefit under 35 U.S.C. § 120 is itself entitled to priority from a prior foreign application, then complete item 18 on the ADDED PAGES FOR NEW APPLICATION TRANSMITTAL WHERE BENEFIT OF PRIOR U.S. APPLICATION(S) CLAIMED.

## 10. Fee Calculation (37 C.F.R. § 1.16)

A. ☒ Regular application

CLAIMS AS FILED			
Number filed	Number Extra	Rate	Basic Fee 37 C.F.R. § 1.16(a) \$710.00
Total Claims (37 C.F.R. § 1.16(c))	8 - 20 =	0 × \$ 18.00	0
Independent Claims (37 C.F.R. § 1.16(b))	2 - 3 =	0 × \$ 80.00	0
Multiple dependent claim(s), if any (37 C.F.R. § 1.16(d))		+ \$270.00	0

☐ Amendment cancelling extra claims is enclosed.

☐ Amendment deleting multiple-dependencies is enclosed.

☐ Fee for extra claims is not being paid at this time.

NOTE: If the fees for extra claims are not paid on filing they must be paid or the claims cancelled by amendment, prior to the expiration of the time period set for response by the Patent and Trademark Office in any notice of fee deficiency. 37 C.F.R. § 1.16(d).

Filing Fee Calculation

\$ 710

B. ☐ Design application  
(\$310.00—37 C.F.R. § 1.16(f))

Filing Fee Calculation

\$

(New Application Transmittal [4-1]—page 6 of 12)

094003 082701

- C. ☐ Plant application  
(\$480.00—37 C.F.R. § 1.16(g))

Filing fee calculation

\$ \_\_\_\_\_

**11. Assertion of Small Entity Status**

- ☐ Applicant hereby asserts status as a small entity under 37 C.F.R. § 1.27

NOTE: 37 C.F.R. § 1.27(c) deals with the assertion of small entity status, whether by a written specific declaration thereof or by payment as a small entity of the basic filing fee or the fee for the entry into the national phase and states:

"(c) Assertion of small entity status. Any party (person, small business concern or nonprofit organization) should make a determination, pursuant to paragraph (f) of this section, of entitlement to be accorded small entity status based on the definitions set forth in paragraph (a) of this section, and must, in order to establish small entity status for the purpose of paying small entity fees, actually make an assertion of entitlement to small entity status, in the manner set forth in paragraphs (c)(1) or (c)(3) of this section, in the application or patent in which such small entity fees are to be paid.

(1) Assertion by writing. Small entity status may be established by a written assertion of entitlement to small entity status. A written assertion must:

(i) Be clearly identifiable;

(ii) Be signed (see paragraph (c)(2) of this section); and

(iii) Convey the concept of entitlement to small entity status, such as by stating that applicant is a small entity, or that small entity status is entitled to be asserted for the application or patent. While no specific words or wording are required to assert small entity status, the intent to assert small entity status must be clearly indicated in order to comply with the assertion requirement.

(2) Parties who can sign and file the written assertion. The written assertion can be signed by:

(i) One of the parties identified in § 1.33(b) (e.g., an attorney or agent registered with the Office), § 3.73(b) of this chapter notwithstanding, who can also file the written assertion;

(ii) At least one of the individuals identified as an inventor (even though a § 1.63 executed oath or declaration has not been submitted), notwithstanding § 1.33(b)(4), who can also file the written assertion pursuant to the exception under § 1.33(b) of this part; or

(iii) An assignee of an undivided part interest, notwithstanding §§ 1.33(b)(3) and 3.73(b) of this chapter, but the partial assignee cannot file the assertion without resort to a party identified under § 1.33(b) of this part.

(3) Assertion by payment of the small entity basic filing or basic national fee. The payment, by any party, of the exact amount of one of the small entity basic filing fees set forth in §§ 1.16(a), (f), (g), (h), or (k), or one of the small entity basic national fees set forth in §§ 1.492(a)(1), (a)(2), (a)(3), (a)(4), or (a)(5), will be treated as a written assertion of entitlement to small entity status even if the type of basic filing or basic national fee is inadvertently selected in error.

(i) If the Office accords small entity status based on payment of a small entity basic filing or basic national fee under paragraph (c)(3) of this section that is not applicable to that application, any balance of the small entity fee that is applicable to that application will be due along with the appropriate surcharge set forth in § 1.16(e), or § 1.16(f).

(ii) The payment of any small entity fee other than those set forth in paragraph (c)(3) of this section (whether in the exact fee amount or not) will not be treated as a written assertion of entitlement to small entity status and will not be sufficient to establish small entity status in an application or a patent."

**WARNING:** 37 C.F.R. § 1.27(c)(4): "Assertion required in related, continuing, and reissue applications. Status as a small entity must be specifically established by an assertion in each related, continuing and reissue application in which status is appropriate and desired. Status as a small entity in one application or patent does not affect the status of any other application or patent, regardless of the relationship of the applications or patents. The refiling of an application under § 1.53 as a continuation, divisional, or continuation-in-part application (including a continued prosecution application under § 1.53(d)), or the filing of a reissue application, requires a new assertion as to continued entitlement to small entity status for the continuing or reissue application."

**WARNING:** "Small entity status must not be established when the person or persons signing the . . . statement can **unequivocally** make the required self-certification." M.P.E.P., § 509.03 (emphasis added).

(complete the following, if applicable)

- ☐ Status as a small entity was asserted in the prior application  
\_\_\_\_\_ / \_\_\_\_\_, filed on \_\_\_\_\_, from which benefit  
is being claimed for this application under:

35 U.S.C. § ☐ 119(e)  
☐ 120  
☐ 121  
☐ 365(c)

and which status as a small entity is still proper and asserted for this  
application.

- ☐ A copy of the written assertion of small entity filed in the prior application  
is included.

**NOTE:** A refund based on establishment of small entity status, of a portion of fees timely paid in full prior to establishing status as a small entity may only be obtained if an assertion under § 1.27(c) and a request for a refund of the excess amount are filed within three months of the date of the timely payment of the full fee. The three-month time period is not extendable under § 1.136. 37 C.F.R. § 1.28(a).

Filing Fee Calculation (50% of A, B or C above)

\$ \_\_\_\_\_

**12. Request for International-Type Search (37 C.F.R. § 1.104(d))**

(complete, if applicable)

- ☐ Please prepare an international-type search report for this application at the time  
when national examination on the merits takes place.

13. Fee Payment Being Made at This Time

☒ Not Enclosed

☒ No filing fee is to be paid at this time.  
(This and the surcharge required by 37 C.F.R. § 1.16(e) can be paid subsequently.)

☐ Enclosed

☐ Filing fee \$ \_\_\_\_\_

☐ Recording assignment  
(\$40.00; 37 C.F.R. § 1.21(h))  
(See attached "COVER SHEET FOR  
ASSIGNMENT ACCOMPANYING NEW  
APPLICATION".) \$ \_\_\_\_\_

☐ Petition fee for filing by other than all the  
inventors or person on behalf of the inventor  
where inventor refused to sign or cannot be  
reached  
(\$130.00; 37 C.F.R. §§ 1.47 and 1.17(i)) \$ \_\_\_\_\_

☐ For processing an application with a  
specification in  
a non-English language  
(\$130.00; 37 C.F.R. §§ 1.52(d) and 1.17(k)) \$ \_\_\_\_\_

☐ Processing and retention fee  
(\$130.00; 37 C.F.R. §§ 1.53(d) and 1.21(l)) \$ \_\_\_\_\_

☐ Fee for international-type search report  
(\$40.00; 37 C.F.R. § 1.21(e)) \$ \_\_\_\_\_

NOTE: 37 C.F.R. § 1.21(l) establishes a fee for processing and retaining any application that is abandoned for failing to complete the application pursuant to 37 C.F.R. § 1.53(f) and this, as well as the changes to 37 C.F.R. §§ 1.53 and 1.78(a)(1), indicate that in order to obtain the benefit of a prior U.S. application, either the basic filing fee must be paid, or the processing and retention fee of § 1.21(l) must be paid, within 1 year from notification under § 53(f).

Total fees enclosed \$ \_\_\_\_\_

14. Method of Payment of Fees

☐ Attached is a ☐ check ☐ money order in the amount of \$ \_\_\_\_\_

☐ Authorization is hereby made to charge the amount of \$ \_\_\_\_\_

☐ to Deposit Account No. \_\_\_\_\_

☐ to Credit card as shown on the attached credit card information authorization form PTO-2038.

**WARNING:** Credit card information should *not* be included on this form as it may become public.

☐ Charge any additional fees required by this paper or credit any overpayment in the manner authorized above.

A duplicate of this paper is attached.

## 15. Authorization to Charge Additional Fees

**WARNING:** If no fees are to be paid on filing, the following items should not be completed.

**WARNING:** Accurately count claims, especially multiple dependent claims, to avoid unexpected high charges, if extra claim charges are authorized.

- ☐ The Office is hereby authorized to charge, in the manner shown above, the following additional fees that may be required by this paper and during the entire pendency of this application.
- ☐ 37 C.F.R. § 1.16(a), (f) or (g) (filing fees)
- ☐ 37 C.F.R. § 1.16(b), (c) and (d) (presentation of extra claims)

**NOTE:** Because additional fees for excess or multiple dependent claims not paid on filing or on later presentation must only be paid or these claims cancelled by amendment prior to the expiration of the time period set for response by the PTO in any notice of fee deficiency (37 C.F.R. § 1.16(d)), it might be best not to authorize the PTO to charge additional claim fees, except possibly when dealing with amendments after final action.

- ☐ 37 C.F.R. § 1.16(e) (surcharge for filing the basic filing fee and/or declaration on a date later than the filing date of the application)
- ☐ 37 C.F.R. § 1.17(a)(1)–(5) (extension fees pursuant to § 1.136(a)).
- ☐ 37 C.F.R. § 1.17 (application processing fees)

**NOTE:** “. . . A written request may be submitted in an application that is an authorization to treat any concurrent or future reply, requiring a petition for an extension of time under this paragraph for its timely submission, as incorporating a petition for extension of time for the appropriate length of time. An authorization to charge all required fees, fees under § 1.17, or all required extension of time fees will be treated as a constructive petition for an extension of time in any concurrent or future reply requiring a petition for an extension of time under this paragraph for its timely submission. Submission of the fee set forth in § 1.17(a) will also be treated as a constructive petition for an extension of time in any concurrent reply requiring a petition for an extension of time under this paragraph for its timely submission.” 37 C.F.R. § 1.136(a)(3).

- ☐ 37 C.F.R. § 1.18 (issue fee at or before mailing of Notice of Allowance, pursuant to 37 C.F.R. § 1.311(b))

**NOTE:** Where an authorization to charge the issue fee to a deposit account has been filed before the mailing of a Notice of Allowance, the issue fee will be automatically charged to the deposit account at the time of mailing the notice of allowance. 37 C.F.R. § 1.311(b).

**NOTE:** 37 C.F.R. § 1.28(b) requires “Notification of any change in status resulting in loss of entitlement to small entity status must be filed in the application . . . prior to paying, or at the time of paying, . . . the issue fee. . . .” From the wording of 37 C.F.R. § 1.28(b), (a) notification of change of status must be made even if the fee is paid as “other than a small entity” and (b) no notification is required if the change is to another small entity.

## 16. Instructions as to Overpayment

**NOTE:** “. . . Amounts of twenty-five dollars or less will not be returned unless specifically requested within a reasonable time, nor will the payer be notified of such amounts; amounts over twenty-five dollars may be returned by check or, if requested, by credit to a deposit account.” 37 C.F.R. § 1.26(a).

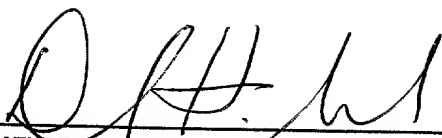
- ☐ Credit Account No. \_\_\_\_\_
- ☐ Refund

FD-230 (2-8-60)

Reg. No. 33701

Tel. No. (215) 963-5055

Customer No.

  
SIGNATURE OF PRACTITIONER  
DANIEL H. GLUB  
(type or print name of attorney)  
101 Market Street  
P.O. Address  
PHILADELPHIA, PA  
19103

[illegible]

☒ Plus Added Pages for New Application Transmittal Where Benefit of Prior U.S. Application(s) Claimed

☐ Plus Added Pages for Papers Referred to in Item 4 Above

☐ Plus added pages deleting names of inventor(s) named in prior application(s) who is/are no longer inventor(s) of the subject matter claimed in this application.

☐ Plus "Assignment Cover Letter Accompanying New Application"

☐ **Statement Where No Further Pages Added**

☐ This transmittal ends with this page.

ADDED PAGES FOR APPLICATION TRANSMITTAL WHERE BENEFIT OF  
PRIOR U.S. APPLICATION(S) CLAIMED

NOTE: See 37 C.F.R. § 1.78.

## 17. Relate Back

**WARNING:** If an application claims the benefit of the filing date of an earlier filed application under 35 U.S.C. § 120, 121 or 365(c), the 20-year term of that application will be based upon the filing date of the earliest U.S. application that the application makes reference to under 35 U.S.C. § 120, 121 or 365(c). (35 U.S.C. § 154(a)(2) does not take into account, for the determination of the patent term, any application on which priority is claimed under 35 U.S.C. § 119, 365(a) or 365(b).) For a c-i-p application, applicant should review whether any claim in the patent that will issue is supported by an earlier application and, if not, the applicant should consider canceling the reference to the earlier filed application. The term of a patent is not based on a claim-by-claim approach. See Notice of April 14, 1995, 60 Fed. Reg. 20,195, at 20,205.

(complete the following, if applicable)

☒ Amend the specification by inserting, before the first line, the following sentence:

## A. 35 U.S.C. § 119(e)

NOTE: "Any nonprovisional application claiming the benefit of one or more prior filed copending provisional applications must contain or be amended to contain in the first sentence of the specification following the title a reference to each such prior provisional application, identifying it as a provisional application, and including the provisional application number (consisting of series code and serial number)." 37 C.F.R. § 1.78(a)(4).

☐ "This application claims the benefit of U.S. Provisional Application(s) No(s).:

APPLICATION NO(S): FILING DATE

\_\_\_\_\_/\_\_\_\_\_"

\_\_\_\_\_/\_\_\_\_\_"

\_\_\_\_\_/\_\_\_\_\_"

## B. 35 U.S.C. Sections 120, 121 and 365(c)

NOTE: "Except for a continued prosecution application filed under § 1.53(d), any nonprovisional application claiming the benefit of one or more prior filed copending nonprovisional applications or international applications designating the United States of America must contain or be amended to contain in the first sentence of the specification following the title a reference to each such prior application, identifying it by application number (consisting of the series code and serial number) or international application number and international filing date and indicating the relationship of the applications. . . . Cross-references to other related applications may be made when appropriate." (See § 1.14(a)). 37 C.F.R. § 1.78(a)(2).



which is a continuation  
of U.S. application number  
08/762,007 filed on  
December 11, 1996, now  
U.S. Patent No. 6,014,641

- ☒ "This application is a  
☒ continuation  
☐ continuation-in-part  
☐ divisional

of copending application(s)

- ☒ application number 09/ 370,290 filed on August 8, 1999"  
☐ International Application \_\_\_\_\_ filed on \_\_\_\_\_ and  
which designated the U.S."  
☐ The international application was published under PCT Article 21(2) in English  
(37 C.F.R. § 1.78(a)(2))

NOTE: The proper reference to a prior filed PCT application that entered the U.S. national phase is the U.S. serial number and the filing date of the PCT application that designated the U.S.

NOTE: (1) Where the application being transmitted adds subject matter to the International Application, then the filing can be as a continuation-in-part or (2) if it is desired to do so for other reasons then the filing can be as a continuation.

NOTE: The deadline for entering the national phase in the U.S. for an international application was clarified in the Notice of April 28, 1987 (1079 O.G. 32 to 46) as follows:

"The Patent and Trademark Office considers the International application to be pending until the 22nd month from the priority date if the United States has been designated and no Demand for International Preliminary Examination has been filed prior to the expiration of the 19th month from the priority date and until the 32nd month from the priority date if a Demand for International Preliminary Examination which elected the United States of America has been filed prior to the expiration of the 19th month from the priority date, provided that a copy of the international application has been communicated to the Patent and Trademark Office within the 20 or 30 month period respectively. If a copy of the international application has not been communicated to the Patent and Trademark Office within the 20 or 30 month period respectively, the international application becomes abandoned as to the United States 20 or 30 months from the priority date respectively. These periods have been placed in the rules as paragraph (h) of § 1.494 and paragraph (l) of § 1.495. A continuing application under 35 U.S.C. 365(c) and 120 may be filed anytime during the pendency of the international application."

- ☐ "The nonprovisional application designated above, namely application  
\_\_\_\_\_/\_\_\_\_\_, filed \_\_\_\_\_, claims the benefit of U.S.  
Provisional Application(s) No(s).:

APPLICATION NO(S).: FILING DATE

\_\_\_\_\_/\_\_\_\_\_ "

\_\_\_\_\_/\_\_\_\_\_ "

\_\_\_\_\_/\_\_\_\_\_ "

- ☐ Where more than one reference is made above please combine all references into one sentence.

18. Relate Back—35 U.S.C. § 119 Priority Claim for Prior Application

The prior U.S. application(s), including any prior International Application designating the U.S., identified above in item 17B, in turn itself claim(s) foreign priority(ies) as follows:

Country	Appln. No.	Filed
The certified copy(ies) has (have)		
<input type="checkbox"/> been filed on _____, in prior application 0 / _____, which was filed on _____.		
<input type="checkbox"/> is (are) attached.		

**WARNING:** The certified copy of the priority application that may have been communicated to the PTO by the International Bureau may not be relied on without any need to file a certified copy of the priority application in the continuing application. This is so because the certified copy of the priority application communicated by the International Bureau is placed in a folder and is not assigned a U.S. serial number unless the national stage is entered. Such folders are disposed of if the national stage is not entered. Therefore, such certified copies may not be available if needed later in the prosecution of a continuing application. An alternative would be to physically remove the priority documents from the folders and transfer them to the continuing application. The resources required to request transfer, retrieve the folders, make suitable record notations, transfer the certified copies, enter and make a record of such copies in the Continuing Application are substantial. Accordingly, the priority documents in folders of international applications that have not entered the national stage may not be relied on. Notice of April 28, 1987 (1079 O.G. 32 to 46).

19. Maintenance of Copendency of Prior Application

**NOTE:** The PTO finds it useful if a copy of the petition filed in the prior application extending the term for response is filed with the papers constituting the filing of the continuation application. Notice of November 5, 1985 (1060 O.G. 27).

A. ☒ Extension of time in prior application

(This item **must** be completed and the papers filed in the prior application, if the period set in the prior application has run.)

☒ A petition, fee and response extends the term in the pending **prior** application until 8/27/01.

☒ A **copy** of the petition filed in prior application is attached.

B. ☐ Conditional Petition for Extension of Time in Prior Application

(complete this item, if previous item not applicable)

☐ A conditional petition for extension of time is being filed in the pending **prior** application.

☐ A **copy** of the conditional petition filed in the prior application is attached.

20. Further Inventorship Statement Where Benefit of Prior Application(s) Claimed

(complete applicable item (a), (b) and/or (c) below)

- (a) ☒ This application discloses and claims only subject matter disclosed in the prior application whose particulars are set out above and the inventor(s) in this application are

☒ the same.

- ☐ less than those named in the prior application. It is requested that the following inventor(s) identified for the prior application be deleted:

\_\_\_\_\_  
(type name(s) of inventor(s) to be deleted)

- (b) ☐ This application discloses and claims additional disclosure by amendment and a new declaration or oath is being filed. With respect to the prior application, the inventor(s) in this application are

☐ the same.

- ☐ the following additional inventor(s) have been added:

\_\_\_\_\_  
(type name(s) of inventor(s) to be deleted)

- (c) ☐ The inventorship for all the claims in this application are

☐ the same.

- ☐ not the same. An explanation, including the ownership of the various claims at the time the last claimed invention was made

☐ is submitted.

☐ will be submitted.

21. Abandonment of Prior Application (if applicable)

- ☒ Please abandon the prior application at a time while the prior application is pending, or when the petition for extension of time or to revive in that application is granted, and when this application is granted a filing date, so as to make this application copending with said prior application.

NOTE: According to the Notice of May 13, 1983 (103, TMOG 6-7), the filing of a continuation or continuation-in-part application is a proper response with respect to a petition for extension of time or a petition to revive and should include the express abandonment of the prior application conditioned upon the granting of the petition and the granting of a filing date to the continuing application.

22. Petition for Suspension of Prosecution for the Time Necessary to File an Amendment

**WARNING:** "The claims of a new application may be finally rejected in the first Office action in those situations where (A) the new application is a continuing application of, or a substitute for, an earlier application, and (B) all the claims of the new application (1) are drawn to the same invention claimed in the earlier application, and (2) would have been properly finally rejected on the grounds of art of record in the next Office action if they had been entered in the earlier application." M.P.E.P. § 706.07(b), 7th ed.

NOTE: Where it is possible that the claims on file will give rise to a first action final for this continuation application and for some reason an amendment cannot be filed promptly (e.g., experimental data is being gathered) it may be desirable to file a petition for suspension of prosecution for the time necessary.

(check the next item, if applicable)

- ☐ There is provided herewith a Petition To Suspend Prosecution for the Time Necessary to File An Amendment (New Application Filed Concurrently)

(Added Pages for Application Transmittal Where Benefit of Prior U.S. Application(s) Claimed [4-1.4]

—page 4 of 5—)

23. Small Entity (37 C.F.R. § 1.28(a))

- ☐ Applicant has established small entity status by the filing of a statement in parent application \_\_\_\_\_/\_\_\_\_\_ on \_\_\_\_\_.
- ☐ A copy of the statement previously filed is included.

**WARNING:** See 37 C.F.R. § 1.28(a).

**WARNING:** "Small entity status must not be established when the person or persons signing the . . . statement can unequivocally make the required self-certification." M.P.E.P. § 509.03, 7th ed. (emphasis added).

24. NOTIFICATION IN PARENT APPLICATION OF THIS FILING

- ☒ A notification of the filing of this

(check one of the following)

- ☒ continuation
- ☐ continuation-in-part
- ☐ divisional

is being filed in the parent application, from which this application claims priority under 35 U.S.C. § 120.

FOIA(b)(7) - D